

### **REMARKS**

Applicants gratefully thank Examiner Jung for taking the time on August 22, 2005, to discuss the pending rejections and applicants' assertion that Stinson et al. does not teach or suggest "*at least two separate bioabsorbable bodies*." As discussed, applicants herewith amend the claims to require "*at least two separately implantable bioabsorbable bodies*." Reconsideration of the rejections set forth in the Final Office Action mailed July 14, 2005, is respectfully requested. Claims 1, 8, 10, 12-15, 18-19, 28-31, 33, and 35 have been amended. Claims 109 and 110 has been newly added. Support for these amendments can be found in the specification at, e.g., paragraph [0064] to paragraph [0070] and Fig. 3A. Additionally, claim 109 corresponds to previously presented claim 44, with amendments to correct the antecedent basis. Therefore, no new matter was added with these amendments. Claims 1-31, 33-35, 109, and 110 remain pending in this application.

Further, in response to the Notice of Non-Compliant Amendment dated October 21, 2005, Applicants note that the Amendment filed on June 2, 2004 (in response to the Office Action mailed on February 6, 2004) added claims 36-43. The Amendment filed on October 12, 2004 (in response to the Office Action mailed July 14, 2005) canceled claims 37-43 and added claim 44. Applicants have, therefore, re-presented claims 36 and 44 as claims 109 and 110, respectively.

### **Double Patenting**

Claims 1-43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-49 of co-pending Application no. 10/114,712 (Our Ref: 032,290-091) in view of Stinson et al (USP 6,340,367). Applicants respectfully assert that claim 1, as currently amended, is patentably distinct from claims 1-49 of the

'712 application in view of Stinson et al. In particular, as discussed more fully in the following section, neither claims 1-49 of the '712 application, nor Stinson et al. teach or suggest a subcutaneous cavity marking device comprising "*at least two separately insertable bioabsorbable bodies.*" Therefore, applicants respectfully request withdrawal of the rejection and reconsideration of the claims as amended.

Art Rejections

Claims 1-15 and 19-43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al. (USP 6,340,367). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al., and further in view of Roth et al. (USP 5,665,063). Claim 18 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al., and further in view of Wolff et al. (USP 5,997,468). Applicants have amended claim 1 to require "*at least two separately implantable bioabsorbable bodies.*" As discussed with the examiner, Applicants assert that the cited references do not teach or suggest all of the limitations of the claims as currently amended. Indeed, Stinson describes only a single implantable body, a stent. The examiner, however, takes the position that the two markers on the stent can be considered "implantable bioabsorbable bodies." Adopting this interpretation, Stinson is ineffective because it has no marker. In any case, in order to clarify the distinction, claim 1 now requires at least two separately implantable bodies. This language clarifies that the "at least two implantable bodies" must be capable of separation. They need not be implanted separately. In fact, the presently claimed invention allows the "at least two separately implantable bodies" to be implanted sequentially, simultaneously, or in any other manner, so long as they are capable of being separated. The device

of Stinson is not capable of being separated because, under the Examiner's interpretation, the "at least two separately implantable bioabsorbable bodies" are bonded to a single stent.

Claim 1 is therefore patentably distinct from the cited art. Claims 2-31 and 33-36 are dependent on claim 1, and are therefore patentably distinct from the cited art for the same reasons.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,  
O'MELVENY & MYERS LLP

Dated: November 10, 2005

By: Diane K. Wong  
Diane K. Wong  
Reg. No. 54,550  
Attorneys for Applicants

DKW/cp

O'Melveny & Myers LLP  
610 Newport Center Drive, 17<sup>th</sup> Floor  
Newport Beach, CA 92660-6429  
(949) 760-9600